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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,496	07/21/2003	Ray Beffa	M4065.0038/P038-D	4998
24998	7590	08/29/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			TON, DAVID	
2101 L Street, NW			ART UNIT	
Washington, DC 20037			PAPER NUMBER	
			2133	

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/622,496

**Applicant(s)**

BEFFA, RAY

**Examiner**

David Ton

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 33-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/21/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. Claims 33-60 are presented for examination.

### ***Double Patenting***

2. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and 8 may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

a). Claim 33 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. patent no. 6,347,386 in view of claim 1 of U.S. patent 5,867,505.

As to claim 33, the patent 6,347,386 teaches the invention substantially as claimed including the steps of performing, identifying [see claim 1].

However, patent 6,347,386 does not teach creating a set of at least one test as a function of the unique identifier of a failed chip and repeating said of at least one test the failed chip.

Patent 5,867,505 teaches teach creating a set of at least one test as a function of the unique identifier of a failed chip and repeating said of at least one test the failed chip [claim 4].

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine claim 1 of patent 6,347,386 and claim 4 of 5,867,505 to provide claim 33 of the instant application. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to have broader claims.

Claims 34-39 are rejected because they are dependent from independent claim 33.

b). Claim 40 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. patent no. 6,128,756 in view of claim 1 of U.S. patent 6,622,270.

As to claim 40, the patent 6,128,756 teaches the invention substantially as claimed including means for performing [testing device, claim 1] and means for repeating [wherein said testing device repeats, claim 1] as set forth in the claim 40. However, patent 6,128,756 does not teach mean for reading.

Patent 6,622,270 teaches means for reading [fuse reader of claim 1].

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine claim 1 of patent 5,870,412 and claim 1 of 6,622,270 to provide a means plus function claim as set forth in claim 40. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to have broader claims.

Claims 41-46 are rejected because they are dependent from independent claim 40.

c). Claim 54 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-19 of U.S. patent no. 6,867,505 in view of claim 1 of U.S. patent 6,622,270.

As to claim 54, the patent 6,867,505 teaches the invention substantially as claimed including system comprising a device tester [means for performing, claim 18] and recording medium [means for storing, claim 19] as set forth in claim 54. However, patent 6,687,505 does not teach a reader for reading identification.

Patent 6,622,270 teaches means for reading identification [fuse reader of claim 1].

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine claims 18-19 of patent 6,867,505 and claim 1 of 6,622,270 to provide a means plus function claim as set forth in claim 54. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to have broader claims.

Claims 55-60 are rejected because they are dependent from independent claim 54.

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re*

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*Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

As to claim 47, it is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,128,756.

Claims 48-53 are rejected because they are dependent from independent claim 47.

### ***Claim Rejections - 35 USC ' 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 54-60 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Larson et al. (Larson) patent no. 5,360,747.

6. As to claim 54, Larson teaches the invention substantially as claimed, including a system comprising a device tester [tester, col. 1 line 42] adapted to perform a principal functional test on a wafer having one or more functional circuit portions [die, see Fig. 2] and produce principal result information indicating respective operation or failure of said one or more functional circuit portions [good die/bad die, col. 1 lines 34-64]; a reader adapted to read an identification device on said integrated circuit as to ascertain an identity of said integrated circuit [accessing the identification memory of claim 1]; and a recording medium adapted to record said identity and said result information and maintain an association therebetween [inking the good die, claim 5].

Larson teaches performing a principal functional test on a wafer but Larson does not explicitly teach performing a principal functional test on an integrated circuit. However, Official Notice is taken that performing a principal functional test on an integrated circuit is well known in the art.

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to modify the teachings of Larson to perform a principal functional test on an integrated circuit well known in the art. This modification would have been obvious and a person having ordinary skill in the art would have been motivated to do so because it would enhance the application of Larson testing a wafer into testing of an IC device.



7. As to claims 55-60, Official Notice is taken that the identification device is a set of anti-fuse or nonvolatile memory such as FLASH memory, EPROM, ROM or CAM is well known in the art.

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to apply the teachings of Larson to perform testing an IC and implement an ID code using a set of anti-fuse or nonvolatile memory such as FLASH memory, EPROM, ROM or CAM as a matter of design choice. This modification would have been obvious and a person having ordinary skill in the art would have been motivated to do so because it would enhance the application of Larson testing a wafer into testing of an IC device

### ***Conclusion***

8. The prior art of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Ton whose telephone number is (571) 272-3828. The examiner can normally be reached on M-Th from 5:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert DeCady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Ton  
Primary Examiner  
Art Unit 2133